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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Volker Schadler

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EXAMINER

ZEMEL, IRINA SOPHIA

ART UNIT

PAPER NUMBER

1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,844	Applicant(s) SCHADLER ET AL.	
	Examiner Irina S. Zemel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection stands as per reasons of record.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 13-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 02/26871 to BASF.,

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(hereinafter BASF '871) or US Patent us Petent 4,540,717 to Mahnke et al., (hereinafter "Mahnke").

The rejection stands as per reasons of record.

Claims 1-3, 5-7 and 13-15, 16, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. or US Patent 4,666,948 to Woerner et al, (hereinafter "Woerner").

The rejection stands as per reasons of record.

Claim Rejections - 35 USC § 103

Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of BASF '871, or US Patent 4,666,948 to Woerner et al, (hereinafter "Woerner") or US Patent us Petent 4,540,717 to Mahnke et al., (hereinafter "Mahnke").

The rejection stands as per reasons of record.

Response to Arguments

Applicant's arguments filed 10-26-2009 have been fully considered but they are not persuasive. The applicants argue that the claims meet the requirements of the 112 first paragraph as being fully enabled. While this is so, the claims were NOT rejected under the provisions of 35 US 112 first paragraph, rather they were rejected under the provisions of 12, **second** paragraph as being indefinite. The rejection clearly stated that "claim is indefinite if undue experimentation is involved to determine boundaries of protection." It is the boundaries of the claims that are not clearly defined by the term

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“obtainable” making the claim indefinite. The rejection, even though it used the language “undue experimentation” commonly used for enablement rejection, nevertheless has nothing to do with enablement, which, apparently, was interpreted as such by the applicants.

With respect to indefiniteness of the term “polycondensation-reactive” resin, the applicants argue that the claim language must be analyzed not in vacuum, “but [*inter alia*] in light of claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made). Present claim 2 recites the polycondensation-reactive resin as an “amino resin,” and present claim 3 further defines the specific types of amino resins. (See also present specification at page 2, lines 35-41). As one skilled in the art would understand these terms, the claim language should be considered definite.” While the examiner agrees that claims can not be interpreted in vacuum, neither the referenced passages from the specification, nor claims 2 or 3 actually define the claimed term so that it can be clearly understood by an ordinary artisan. Just because the resin is defined as “amino-resin” or urea-formaldehyde” resin (or some other resin), does not provide any information regarding the “polycondensation-reactivity” of the resin. While all of the defined resins are of polycondensation type (the term known to an ordinary artisan and well recognized in the art), there is nothing that would explain to an ordinary artisan what is meant by “reactive”, i.e., whether the resins are still reactive to further polycondensation reaction or the term polycondensation-reactive is used in place of commonly used and

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accepted term "polycondensation" resins, i.e.. resins obtained via a polycondensation reaction (as opposed to polyaddition polymerization).

With respect to the art rejection, the applicants argue that the claims are not anticipated because the references do not disclose each and every limitation of the claims, specifically, the pore size. It is noted that none of the product claims were rejected under the provisions of 35 USC 102 alone.

It is noted that contrary to the applicants statement, claim 1 is NOT a process claim, rather it is a product claim drafted in a "product-by-process" format.

All of the product claims were rejected under 102/103, which has been long approved by the courts. Specifically, the courts have established that "[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section **102** or section **103** of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Moreover, it has been also established by the courts that

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985), and that "The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

In the instant case, the examiner expressly discussed all the factors (such as starting materials and process steps disclosed in the prior art) thus providing rationale why the disclosed products appears to be the same as the claimed products. The burden was shifted to the applicants to provide factual evidence that the disclosed products do not exhibit the claims properties (nanopores). The applicants, however, did not present any factual evidence. The applicants did not even argue that the processes disclosed in the prior art references are different from the claimed process (recited in the product-by-process claims). The applicants only picked small portion of

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the references that disclose processes that may be different from the recited process steps of the instant claims. It is noted, that the examiner expressly addressed the portions of the references disclosing the processes that appears to be substantially identical to the claimed process (even though, the disclosure of the references, in some cases, was directed to a non-preferred embodiments). The applicants did not address those portions of the references. Instead of providing the evidence of the disclosed foams being different from the claimed foams, the applicants discuss what the reference does not disclose, i.e., the cell size. However, simply because the reference does not disclose some inherent property of the product does not make the product either patentable or different. The examiner has established the prima facie case of obviousness and provided enough rationale supporting her position why she believes the claimed product is not patentable distinguishable for the product disclosed in the prior art. As discussed above, the applicants failed to meet their burden to rebut the prima facie obviousness by presenting either evidence to the contrary of any convincing arguments.

No arguments is presented with respect to rejection of process claims 8-12. The applicants refer to their arguments for claim 1, which, as discussed above, is not even a process claims and the criteria for patentability of the product –by-process is different than for process itself.

The rejection, therefore, stands as per reasons set forth above and in the previous office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Irina S. Zemel
Primary Examiner
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ISZ